

PATENT
Docket No: ST02001USU (159-US-U1)
Serial No.: 10/523,669

REMARKS

STATUS SUMMARY

Claims 1-26 are pending in the present application, and are subject to a restriction and/or election requirement. In the present paper, in response to the restriction requirement, claims 18-24 and 26 have been withdrawn as being drawn to non-elected subject matter. Claims 19-23 of the withdrawn claims have been amended.

RESTRICTION REQUIREMENT

SPECIES I AND II

In the Office Action dated March 30, 2007, the Examiner indicated that the present application contains claims directed to the following inventions:

Group I: Claims 1-17, drawn to a process.

Group II: Claims 18-26, drawn to an apparatus.

The Examiner requires applicants, in accordance with 37 C.F.R. § 1.499, to elect a single disclosed invention for prosecution on the merits to which the claims must be restricted. In response, applicants respectfully disagree with the Examiner that the application contains claims that do not relate to one invention only or to a group of inventions so linked as to form a single general inventive concept as required by PCT Rule 13.1 and therefore traverse this election requirement for the following reasons. Under 37 C.F.R. § 1.499, "a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories: (4) A

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process and an apparatus or means specifically designed for carrying out the said process[.]” Applicants respectfully submit that claim 18 is an apparatus claim having means specifically designed for carrying out the process of claim 1, to-wit, converting received protocol aiding data to interface data that is transparent to a call processor within a mobile device, and therefore meets the unity of invention of PCT Rule 13.

Nevertheless, in order to further the prosecution of this application, applicants hereby elect the subject matter corresponding to Group I, claims 1-17, for prosecution on the merits in the present application. In addition, applicants respectfully submit that claim 25, directed to a method for processing protocol aiding data, properly belongs to Group I, and should be prosecuted together with claims 1-17 of Group I.

Accordingly, claims 18-24 and 26 have been withdrawn subject to applicants’ right to resubmit the withdrawn claims in one or more continuation applications.

SPECIES A AND B

The Examiner further requires applicants to elect between species A, embodiment of FIG. 6, and B, embodiment of FIG. 7. Again, applicants respectfully disagree with the Examiner that the claims related to FIG. 6, *i.e.*, a mobile device utilizing a finite state machine (“FSM”) in a GSM environment, and the claims related to FIG. 7, *i.e.*, a mobile device utilizing a finite state machine (“FSM”) in a CDMA environment, do not relate to one invention only or to a group of inventions so linked as to form a single general inventive concept as required by PCT Rule 13.1 and therefore traverse this election requirement for the following reasons.

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Referring to MPEP § 1850, II., the example of independent claims to A + X, A + Y, and X + Y is given where the independent claims to A + X and A + Y indicate unity of invention *a priori* as A is common to both claims. However, if it is established that A is known, "there is lack of unity *a posteriori*, since A (be it a single feature or a group of features) is not a technical feature that defines a contribution over the prior art."

In other words, if element A is a "special technical feature" that defines a contribution over the prior art, there will be unity of invention as to any independent claims having A as an element, as well as other known elements. Applicants respectfully submit that claims 5, 9, 10, 11, 12, and 13, all of which claim from claim 4, and claims 6, 7, and 8, all of which claim from claim 5, have unity of invention because both sets of claims include a common "special technical feature" found in their respective base claims.

Again, in order to further the prosecution of this application, applicants hereby elect the subject matter corresponding to the claims related to FIG. 7, *i.e.*, claim 5, for prosecution on the merits in the present application.

SPECIES A, B, AND C

The Examiner further requires applicants to elect between species a, claim 6; b, claim 7; and c, claim 8. Applicants respectfully disagree with the Examiner as to an election of species required for species a, b, and c for the same reasons stated as to species A and B. However, in order to further the prosecution of this application, applicants hereby elect claim 6 for prosecution on the merits in the present application.

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Applicants further note that under 37 CFR 1.141(a), "more than one species of an invention, not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form (§ 1.75) or otherwise include all the limitations of the generic claim." *See also* 37 CFR 1.146 ("the examiner may require restriction of the claims to not more than a reasonable number of species before taking further action in the application"). Moreover, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." MPEP § 803 (Restriction- When Proper).

Applicants believe, in general, that the search and examination of all claims of the entire application can be made without serious burden, and therefore the restriction/election requirements of the pending Office action are improper.

SUMMARY

With traversal, applicants have selected claims 1, 2, 3, 4, 5, 6, 14, 15, 16, 17, and 25 for further prosecution on the merits in the present application, for a total of 11 claims, with the remaining claims being withdrawn without prejudice.

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CONCLUSION

In light of the above remarks, it is respectfully submitted that the present application is now in proper condition for allowance, and an early notice to such effect is earnestly solicited.

If any small matter should remain outstanding after the Patent Examiner has had an opportunity to review the above Remarks, the Patent Examiner is respectfully requested to telephone the undersigned patent attorney in order to resolve these matters and avoid the issuance of another Office Action.

Respectfully submitted,

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